

of obviousness-type double patenting as allegedly being unpatentable over claims 1-4 of the Baker patent in view of Milligan *et al.*, U.S. Patent No. 5,795,870 to Kahne ("the Kahne patent") and U.S. Patent No. 5,739,118 to Carrano *et al.* ("the Carrano patent"). Claims 17 and 18 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 5-7 of U.S. Patent No. 6,087,489. Applicants traverse the rejections. However, solely for purposes of advancing prosecution, Applicants have canceled claims 1, 8, 10-18. Applicants respectfully request reconsideration and withdrawal of the rejections.

Claims 27, 28 and 31-33 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 21 and 28-32 of copending Application No. 08/847,151. Applicants reiterate that since the rejection is provisional in nature, it will be addressed when there is an indication of otherwise allowable subject matter in the present application and can be resolved through the filing of a suitable terminal disclaimer.

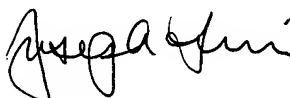
Claims 27-29 stand rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. Applicants respectfully traverse this rejection, as there is no reason of record to believe that those skilled in the art would not be able to practice the claimed inventions to at least some measurable extent. However, solely for purposes of advancing prosecution, Applicants have amended claim 27 to recite a method of modulating expression of a target nucleic acid comprising administering into the alimentary canal an effective amount of an oligonucleotide comprising 2'-O-alkyl or 2'-O-alkoxyalkoxy modifications. Such claims are acknowledged by the Examiner to be

enabled as provided on page 4 of the Office Action.¹ Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 1, 8 and 10 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by the Baker patent, and in the alternative, under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hanecak *et al.*, in view of Milligan *et al.*, the Kahne patent and the Carrano patent. Applicants traverse the rejections. However, solely in order to facilitate prosecution, Applicants have canceled claims 1, 8 and 10. Thus, the rejections have been rendered moot.

In view of the foregoing, Applicants submit that the claims presently before the Examiner are in condition for allowance. An Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,



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¹ The Office Action on page 4 indicated that “while being enabling for methods of modulating expression of a target nucleic acid comprising administering into that alimentary canal an effective amount of an oligonucleotide comprising 2'-O-alkyl or **2'-O-alkoxy** modifications . . .” Applicants note, however, that claims 31-33, which recite **2'-O-alkoxyalkoxy** modifications, were not rejected as allegedly lacking enablement. Applicants believe that the Examiner mistakenly inserted “2'-O-alkoxy” in place of “2'-O-alkoxyalkoxy”.

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Claims 1, 8 and 10-18 were canceled. Claim 27 was amended as follows:

27. (Amended) A method of modulating expression of a target nucleic acid comprising administering into the alimentary canal an effective amount of an oligonucleotide [that has at least one nitrogenous heteroatomic backbone modification,] comprising a 2'-O-alkyl or 2'-O-alkoxyalkoxy modification, wherein said oligonucleotide hybridizes to said target nucleic acid, and modulates expression thereof.